

REMARKS/ARGUMENTS

In response to the Office Action of January 3, 2007, Applicant requests reconsideration of this application for patent pursuant to 35 U.S.C. 132.

Claim Status/ Support for Amendments

No new matter has been added to the amendments to the claims made herein. Claims 12, 14-16, and 18-21 are currently pending in this application.

Claims 12 has been amended herein to specifically recite a handle having a receptacle for a chemiluminescent light stick that is held in a vertical position. Claim 20 has been amended to define the handgrip as two legs connected by a bridge..Support for this amendment can be found throughout the specification as filed, see for example, Figure 4.

Rejection under 35 USC 103(b)

The Examiner states that Claim 12, 14-16, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koch, III, US Patent 5,299,720, in view of Kobdich, US Patent 6,186,383.

The Examiner points to embodiment of figures 8-10 of Koch stating that provides what is considered a safety handle capable

of being used for temporary attachment to a pier piling for use by passengers during boarding and exiting a boat, said safety handle comprising a base member 4 constructed of a relatively flexible sheet of material, said base member further defined as having a front surface 8 and a back surface bounded by a top edge and a bottom edge with a first and second side edge, a handgrip 3 secured to said back surface, said handgrip formed with a receptacle 5a, said receptacle sized so as to be capable of receiving a light stick, a pair of straps 9 connected to said base member, one said strap adapted to extend around said piling, as claimed.

The Applicant respectfully disagrees with the Examiners characterization of the Koch device. Figures 8-10 are detailed by Koch in Column 3 starting at line 60 where the handle and friction connector 1 is constructed and arranged as an attachment to a drink container, utility container, or the like. Koch combines his handle for use in coupling to a tubular bike frame or boat railing. The Koch handle could not operate as a receptacle for a light stick without modification. Modification of the Koch handle would make it non-operative for its intended purpose, namely, securement to tubular bike rail or boat railing. To use the Koch device has a handgrip in entering or exiting a

boat would be most dangerous as the split handle could injury a person. The purpose of the Applicant's invention is to provide a safety device for ingress and egress to a boat so that the handle must be smooth, not have a design for securment to a tubular pipe.

The Examiner states that Koch provides the claimed invention except (1) said front surface adapted to contact an including integrally formed rigid protrusions designed to temporarily prohibit movement of said base member, as claimed; (2) said receptacle made of a material permitting light to shine through, wherein said base member and said hand grip are plastic, and said hand grip receptacle being translucent, as claimed; (3) said base member is wood; and (4) said strap is of a length sufficient to encircle said piling between 6 inches and 20 inches.

The Examiner states that regarding (1), Koch discloses the handle for engagement with a metal surface. Kobdich teaches rigid projections 26 for engagement with metal surfaces for improved clamping/attachment purposes. It would have been obvious to include rigid projections on the device of Koch for the purpose of improving attachment of the device, particularly to metal surfaces.

The Applicant wishes to illustrate that the Applicant's protrusions are for engaging a wood piling. The Applicant is not attempting to engage any metal device as set forth in Koch or Kobdich. Wood pilings used in the boating industry are subject to extreme weather conditions resulting in cracking, splintering, worm growth, and so forth. All of which makes for a slippery surface when wetted. The use of a material that is capable of passing light has no purpose with Koch or Kobdich and would not add any safety provision to their use of "handles". However, the use of a material capable of passing light has a very important safety factor with the Applicant, the placement of the handle on a vertical piling provides an illuminated handle that would otherwise be most dangerous to produce. Even if the industry made a chemiluminescent light stick that could fit in the handle of Koch, which it does not, placement in an open position would be even more dangerous for any individual to grasp as they could pull the stick away from the handle.

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flexible sheet of material, said base member further defined as having a front surface 8 and a back surface bounded by a top edge and a bottom edge with a first and second side edge, a handgrip 3 secured to said back surface, said handgrip formed with a receptacle 5a, said receptacle sized so as to be capable of receiving a light stick, a pair of straps 9 connected to said base member, one said strap adapted to extend around said piling, as claimed.

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The Examiner states that regarding (2) and (3), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device in these ways, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

The Applicant respectfully requests the Examiner to

reconsider the rejection as the Koch and Kobdich devices are not directed for use with pilings so the material of design does make a difference. The Koch device was designed as a handle for carrying bottles and the like containers, thus Koch did not have to address vertical placement or the hand grip necessary for an individual attempting to enter a boat that is likely moving on the water due to weight action and/or normal movement of a boat when boarding.

The Examiner states that regarding (4), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device in this way, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Applicants respectfully disagree with the Examiner's determination that the invention as claimed is obvious. In order for an Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met (MPEP 2142). First there must be some suggestion or motivation, either in the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of

success. Finally, the prior art reference (or references) when combined must teach or suggest all of the claimed limitations.

The preamble of both claims 12 and 20 recite a safety handle for temporary attachment to a pier piling for use by passengers during boarding and disembarking a boat. It has been held that the preamble can serve to limit claim scope if it "recites essential structure or steps", or it is "necessary to give life, meaning, and vitality" to the claim. *Catalina Mkrgr. Int'l, Inc. v. Coolsavings Com. Inc.* 289 F.3d 801, 803, 808 (Fed. Cir. 2002), see also *Piney Bowes, Inc. v Hewlett-Packard, Co.* 182 F.3d 1298, 1305 (Fed. Cir. 1999). Applicants contend that the pier piling and boat are not merely statements of intended use. In this case, the pier and the boat are essential structures which are necessary to give meaning to the body of claims 12 and 20. Thus, these elements must be evaluated and considered just like any other limitation of the claim to determine whether the claim distinguishes over the prior art since it sets definite boundaries on the patent protection sought.

Therefore, Applicants respectfully submit that the prior art references when combined fail to teach or suggest all of the claimed limitations. Moreover, there is no motivation for combining the dissimilar devices of Koch and Kobdich for the

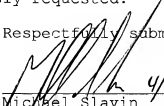
Appl. No. 10/729,698 Amdt. dated Reply to Office action of January 3, 2007

reasons delineated above. Even if there were a reason to combine, the result would not be a stationary handle for mounting on an immovable piling for stabilizing movement onto or off a boat.

SUMMARY

In light of the foregoing remarks and amendment to the claims, it is respectfully submitted that the Examiner will now find the claims of the application allowable. Favorable reconsideration of the application is courteously requested.

Respectfully submitted,



Michael Slavin

Registration # 34,016

McHale & Slavin, P.A.

2855 PGA Boulevard

Palm Beach Gardens, FL 33410

(561) 625-6575 (Voice)

(561) 625-6572 (Fax)

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